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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,373	09/24/1999	YUKIKO TAKEDA	NIT-153	8297
24956	7590	12/05/2003		
MATTINGLY, STANGER & MALUR, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER HARPER, KEVIN C	
			ART UNIT 2666	PAPER NUMBER 8

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/404,373

Applicant(s)

TAKEDA, YUKIKO

Examiner

Kevin C. Harper

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. Figures 2 and 20 are objected to because items 1 and 7, respectively, require descriptive wording (37 CFR 1.83(a)). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 2 is objected to because it is not numbered. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bajzath et al. (US 6,144,644).

1. Regarding claims 1 and 4, Bajzath discloses an AIN SCP (Figure 2, item 154) connected to switches of a transport layer network (item 210) over a signaling network (col. 3, lines 59-64) and connected with the Internet (item 120) through a gateway (item 215; Figure 6A, steps 630-660). The SCP comprises a first means for storing connection information in a user table (Figure 6A, step 640) after a request for call waiting has been received (step 610) for a terminal (Figure

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2, item 130) connecting to the Internet (item 120) from the transport layer network. The SCP also comprises a second means for sending the incoming call notification to the gateway (Figure 6A, steps 640-650; col. 6, lines 30-32) to indicate that the terminal has received a call from a second terminal in one of the switching systems (Figure 6A, step 620). Further regarding claim 4, the Internet call waiting request message is inherently sent from the user to the SCP (col. 6, lines 41-50; note: the state of the call is undetermined until acted upon by the SCP in response to a user decision communicated through the call waiting server). An appropriate control program on the SCP is inherently identified (col. 4, lines 45-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bajzath et al., as applied to claims 1 or 4 above, in further view of Low (US 6,282,281).

2. Regarding claim 2, the user information table contains a telephone number for the terminal (col. 6, lines 22-24) and an flag indicating whether or not the terminal is connected to the Internet (col. 5, lines 13-16; col. 6, lines 18-24). However, Bajzath does not include storing an address for the gateway. Low discloses an SCP transmitting data to a network service device via the Internet (Figures 6 and 13; col. 14, lines 46-50) using an inherently stored address (col. 15, lines 25-29). Therefore, it would have been obvious to one skilled in the art at the time the

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invention was made to have an SCP connected to a network service device or gateway in the invention of Bajzath in order to communicate inexpensively over the Internet with other network service devices to perform Internet-based services for users.

3. Regarding claims 5 and 6, an incoming call notification message (Figure 5A, step 520; col. 5, lines 44-49) in a PSTN protocol (col. 3, lines 50-64) is transmitted to a call waiting server. However, Bajzath does not disclose that the protocol of the message is converted. Low discloses an SCP converting a service request in order to transmit the request to a network service device via the Internet (Figures 6 and 13; col. 14, lines 46-50). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have an SCP convert the protocol of an incoming call notification message in the invention of Bajzath in order to communicate inexpensively over the Internet and to convert to a protocol understood and useable by a network service device on the Internet.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bajzath et al., as applied to claim 1 above, in further view of Benson (US 6,104,800).

4. Bajzath discloses that a user may accept an call (col. 6, lines 41-43) in response to a user notification (col. 6, lines 33-41). However, Bajzath does not disclose that a switching system carries out the connection for the call. Benson discloses if a user elects to receive a phone call, a data call is put on hold by a switching system while the voice call goes through to the user (col. 6, lines 23-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a switching system carry out a connection for an incoming call in the invention of Bajzath to allow the call to be received through a normal telephone instead of through a computer (Bajzath, col. 6, lines 41-43).

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Conclusion

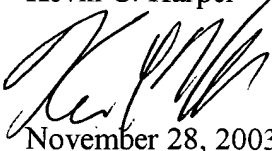
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Devillier et al. (US 6,366,661; Figure 2) and Bedingfield et al. (US 2002/0085542; Figures 1 and 5) each discloses an SCP used for providing Internet call waiting.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 703-305-0139. The examiner can normally be reached weekdays, except Wednesday, from 9:30 AM to 8:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 703-308-5463. The centralized fax number for the Patent Office is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office for TC 2600 at 703-306-0377.

Kevin C. Harper



November 28, 2003

Seema S. Rao
SEEMA S. RAO 12/1/03

**SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**